

REMARKS**Rejection under 35 U.S.C. §103(a)**

Claims 1 and 3-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vanderbilt, et al. in combination with Applicant's own disclosure.

Applicants respectfully traverse this ground of rejection. Applicants also respectfully submit that "in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, **the prior art references must teach or suggest all the claims limitations.** The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, **and not based on applicants' disclosure.**" See MPEP § 2142, citing In re Vaeck, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

The issue of motivation is properly addressed in terms of one of ordinary skill in the art **who has not had access to Applicant's Specification.** As set forth by the Federal Circuit in In re Dow Chemical, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988) "the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art". The proper standard clearly required by the Federal Circuit is that **"both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure"**. The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient to establish *prima facie* obviousness.

The present invention is directed to a method of producing mixtures of polyvinyl chloride and polymers based on conjugated dienes and acrylonitrile, comprising the steps of mixing **powdered polyvinyl chloride with latexes based on conjugated dienes and acrylonitrile**, and coagulating the mixture, wherein the powdered polyvinyl chloride is a polyvinyl chloride having a mean particle diameter in the range from 5 to 200 µm and K values (DIN 53726/ISO 1628) of from 40 to 90. Applicants submit that Vanderbilt, et al. in combination with Applicant's disclosure does not render the present invention obvious.

Vanderbilt, et al. discloses two methods of mixing NBR and PVC. The first method is known as a "dry-blend" method and involves mixing NBR and powdered PVC. See the Examples. The second method involves mixing the latices of NBR and PVC, i.e. mixing

latices of rubber with latices of PVC, otherwise known as the "latex blend method". See column 2, lines 24-26, "the latices of the rubber and the polyvinyl chloride may be mixed...". Each Example disclosed in Vanderbilt, et al. discloses the dry-blend method, i.e. mixing NBR with powdered PVC on a rubber mill.

Vanderbilt, et al. does not teach or suggest mixing powdered PVC as specifically claimed with latexes based on conjugated dienes and acrylonitrile. Applicants further submit there is no motivation to use powdered PVC as disclosed in the dry method in Vanderbilt, et al. with the latex of NBR disclosed in the second method of Vanderbilt, et al. Applicants do not submit that the powdered PVC disclosed in Vanderbilt, et al. meets the limitations of the claimed invention. There is no motivation to pick and choose the components as specifically claimed in the process of the present invention based on the disclosure of Vanderbilt, et al.

Applicants further submit there is no motivation to use the PVC as claimed in the present invention having the claimed particle diameter and K-values. In the alternative, it is only apparent to one skilled in the art to arrive at the instant invention after reading Applicants disclosure. Applicants submit that while page 3, lines 21-24 discloses that commercially available PVC's can be used, there is no motivation in the prior art or submitted by the Examiner illustrating that one skilled in the art would have been motivated to combine the claimed PVC with latexes based on conjugated dienes and acrylonitriles. As discussed at page 2, there are disadvantages to the two methods disclosed by Vanderbilt, et al., i.e., not economical. There is no motivation present in Vanderbilt, et al. to provide an inexpensive and environmentally method of producing mixtures of PVC and NBR as claimed in the present invention. For at least these reasons, Applicants respectfully request withdrawal of this ground of rejection.

Respectfully submitted,

Bayer Polymers LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741
(412) 777-3879
FACSIMILE PHONE NUMBER:
(412) 777-3902
lc/SENG/jrs178

By

Jennifer R. Seng
Attorney for Applicants
Reg. No. 45,851

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